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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,595	09/28/2006	Yukio Kato	0230-0242PUS1	5586

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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CHEN, SHIN LIN

ART UNIT	PAPER NUMBER
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1632

NOTIFICATION DATE	DELIVERY MODE
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04/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,595	<b>Applicant(s)</b> KATO ET AL.	
	<b>Examiner</b> Shin-Lin Chen	<b>Art Unit</b> 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 11, 13-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-22-10</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicant's amendment filed 1-22-10 has been entered. Claims 8, 13 and 14 have been amended. Claims 10, 12 and 16 have been canceled. Claims 17 and 18 have been added. Claims 1-9, 11, 13-15, 17 and 18 are pending. Claims 8, 9, 11, 13-15, 17 and 18 are under consideration.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 9, 11 and 13-15 remain rejected and newly added claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and is repeated for the reasons set forth in the preceding Official action mailed 10-22-09. Applicant's arguments filed 1-22-10 have been fully considered but they are not persuasive.

Applicant argues that claim 8 has been amended to recite specific recited mesenchymal stem cell (MSCs) migration-enhancing factor and require administering mesenchymal stem cells exogenously and MSCs can be administered by injection, intravascular injection, injection via circulatory system or intraperitoneal injection. Example 4 teaches hypodermic injection of PDGF-BB and MSCs injected into tail vein.. The disclosure of the specification fulfills the

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enablement requirement and no undue experimentation is required (amendment, p. 8-9). This is not found persuasive because of the reasons set forth in the preceding Official action mailed 10-22-09. The claims read on administering numerous different proteins or peptides in combination with MSCs for regenerating injured tissue in vivo. The art of delivering a protein complex to various target sites in vivo was unpredictable at the time of the invention. The administration route includes direct injection or application, subcutaneous, intravenous, intramuscular, intraperitoneal, oral, topical, dermal, transdermal, and intranasal administration etc. There are various barriers before a protein can reach its target cells, for example, layers of dermal cells, blood vessel wall cell membranes, proteases and lysosomal degradation within cells, extracellular matrix between cells, gastrointestinal digestive acids, and blood-brain barrier for reaching cells in the brain. Whether the protein can reach target cells in vivo or not depends on the administration route of said protein. The MSCs also can be administered via various administration routes. The specification only discloses that GFP-MSCs injected through the tail vein of rats can migrate to the calves or migrate and accumulate in greater amounts at the site where PDGF-BB was localized (Example 4). The specification fails to provide adequate guidance and evidence for whether administration of MSCs and the claimed factor via various administration routes would be able to reach the target site or injured tissue in a subject and sufficient MSCs and the claimed factor can be obtained at the target site or injured tissue so as to enhance regeneration of the injured tissue in vivo. Whether the administered MSCs and claimed factor via various administration routes would be able to enhance regeneration of the injured tissue in vivo was unpredictable at the time of the invention. Absent specification guidance, one

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skilled in the art at the time of the invention would require undue experimentation to practice over the full scope of the invention claimed.

***Conclusion***

No claim is allowed.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (571) 272-0726. The examiner can normally be reached on Monday to Friday from 9:30 am to 6 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for this group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Shin-Lin Chen, Ph.D.  
/Shin-Lin Chen/  
Primary Examiner  
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